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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,216	08/24/2000	Chris Carmichael	SD-CARMI-SCH051006-1-sxg	4406
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FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER MEINCKE DIAZ, SUSANNA M	
			ART UNIT 3692	PAPER NUMBER
			NOTIFICATION DATE 01/06/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

09/645,216

Applicant(s)

CARMICHAEL ET AL.

Examiner

Susanna M. Diaz

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006 and 26 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
Paper No(s)/Mail Date 3/8/02

DETAILED ACTION

1. This non-final Office action is responsive to the revival of the instant application. The petition for revival was granted on September 26, 2008.

In a response filed by Applicant on July 13, 2006, Applicant elected Group I (claims 1-9) without traverse.

Claims 10-25 stand as non-elected.

Claims 1-9 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites the steps of "providing a remote computer" and "providing a graphical user interface." The scope of providing is vague and indefinite. Does providing merely encompass the act of making the computer and graphical user interface available? Is it intended to refer to the act of actively using the computer and graphical user interface? At present, "providing" merely implies that the computer and graphical user interface are available for use (and not necessarily used within the scope of the claim).

Claim 1 recites that "each of said modules is directed to the specific needs of one known population demographics." It is not clear what this limitation encompasses. What is meant by "population demographics"? Are demographics specific to indicators such as age, income, or gender, or do they merely refer to any information used to profile and characterize people and their interests? Within the scope of the claim language, both are acceptable interpretations. Subsequently, a user can search each of these modules; therefore, it is not clear what is special about each module in terms of each module being directed to the specific needs of one known population. Is each module specific to one type of demographic? Are all modules potentially useful to one type of demographic? The relationship between the modules and demographics is unclear.

Later, a member of the demographic submits a request to search the contents of one of the plurality of modules. This does not preclude the member from searching from more modules. Again, it is not understood how the modules are related to the demographics.

Dependent claims 2-9 do not remedy these problems and therefore inherit the same rejections under 35 U.S.C. § 112, 2nd paragraph.

Appropriate correction is required.

The following art rejection reflects the Examiner's best understanding of the claimed invention, especially in light of the rejections under 35 U.S.C. § 112, 2nd paragraph.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Vanderveldt et al. (U.S. Patent No. 6,266,668).

Vanderveldt discloses a method of providing lifestyle specific information over a global computer network, said method comprising the steps of:

[Claim 1] providing a remote computer having a memory, wherein the memory has stored therein one or more data searching programs and a plurality of modules, each module comprising a plurality of data structures, wherein the data structures comprise data, and wherein the data of each of said plurality of data structures of each of said modules is directed to the specific needs of one known population demographic (Abstract; Figs. 1-5; columns 2-4; col. 8, line 41 through col. 9, line 34; col. 10, lines 47-57);

providing a graphical user interface in communication with the remote computer, said graphical user interface enabling a user to search each of the modules for desired information (Abstract; Figs. 1-5; columns 2-4; col. 8, line 41 through col. 9, line 34; col. 10, lines 47-57);

receiving, using the remote computer, a request from a member of the demographic to search the contents of one of the plurality of modules for information of interest to said member (Abstract; Figs. 1-5; columns 2-4; col. 8, line 41 through col. 9, line 34; col. 10, lines 47-57 – The profile of a user implies demographics. Demographic data is specifically mentioned in col. 10, lines 47-50);

searching, using the one or more data searching programs, one or more data structures of said module for data representative of the desired information (Abstract; Figs. 1-5; columns 2-4; col. 8, line 41 through col. 9, line 34; col. 10, lines 47-57 – After retrieving data from external search engines, the data mining engine narrows down information of interest even more based on the user's profile);

finding, using the one or more data searching programs, data representative of the desired information (Abstract; Figs. 1-5; columns 2-4; col. 8, line 41 through col. 9, line 34; col. 10, lines 47-57); and

transmitting, using a computer, said data to the requesting member (Abstract; Figs. 1-5; columns 2-4; col. 8, line 41 through col. 9, line 34; col. 10, lines 47-57).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanderveldt et al. (U.S. Patent No. 6,266,668), as applied to claim 1 above, in view of Official Notice.

Regarding claims 2-7, Vanderveldt does not explicitly disclose that a first one of said plurality of modules comprises information relating to world travel (claim 2), a first data structure of said first module includes data comprising flight schedules (claim 3), a second data structure of said module comprises data about travel tours (claim 4), a second one of said plurality of modules comprises multimedia presentations (claim 5), a first data structure of said second module comprises streamable video data (claim 6), or a second data structure of said second module comprises audio data (claim 7). More specifically, Vanderveldt does not expressly teach the specific data recited in claims 2-7 (e.g., data regarding world travel, flight schedules, travel tours, multimedia presentations, streamable video, and audio). These differences are only found in the non-functional descriptive material and are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP § 2106.

Nevertheless, Official Notice is taken that it was old and well-known in the art of targeting information to customize information presented to a user based on data comprising any of data regarding world travel, flight schedules, travel tours, multimedia presentations, streamable video, and audio. The Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Vanderveldt such that a first one of said plurality of modules comprises information relating to world travel (claim 2), a first data structure of said first module includes data comprising flight schedules (claim 3), a second data structure of said module comprises data about travel tours (claim 4), a second one of said plurality of modules comprises multimedia presentations (claim 5), a first data structure of said second module comprises streamable video data (claim 6), or a second data structure of said second module comprises audio data (claim 7) in order to more effectively target users (with a wide variety of interests) with information that is best customized to the special interests of each respective user.

[Claims 8-9] Vanderveldt returns search results to a user based on the user's profile, which also includes an analysis of demographics (col. 9, lines 1-27; col. 10, lines 47-57), yet Vanderveldt does not explicitly disclose that the population demographic is determined by a known and specific lifestyle (claim 8), wherein the lifestyle is characterized by an interest in sports (claim 9). Official Notice is taken that it was old

and well-known in the art at the time of Applicant's invention to incorporate a user's lifestyle information in his/her profile. Further, Official Notice is taken that it was old and well-known in the art at the time of Applicant's invention to characterize a user's lifestyle by an interest in sports. The Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Vanderveldt such that the population demographic is determined by a known and specific lifestyle (claim 8), wherein the lifestyle is characterized by an interest in sports (claim 9) in order to more effectively capture more aspects of a user's personality, thereby improving Vanderveldt's ability to provide users with information that is truly of interest to them. The ability to track an interest in sports makes Vanderveldt more comprehensive in its ability to provide data of varying interests. Furthermore, these differences are only found in the non-functional descriptive material and are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); *In re Ngai*, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP § 2106.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692